

REMARKS

This amendment is submitted in conjunction with a Request for Continued Examination under 37 C.F.R. § 1.114. Claims 1-19 are pending in the application. New claim 19 is added by this Amendment. Reconsideration and allowance of the claims in light of the amendments and arguments herein is respectfully requested.

Prior art rejection

Claims 1-2, 4, 6-9, 11, 13-14, 16 and 18 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over US patent number 6,839,420 to Koponen ("Koponen") in view of US patent number 4,899,373 to Lee, et al ("Lee"). Claims 3, 5, 10, 12 and 15 and 17 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over Koponen in view of Lee and further in view of US patent number 5,206,899 to Gupta, et al. ("Gupta"). Reconsideration of these rejections is respectfully requested.

The prior art of record fails to show all the features of independent claims 1, 8 and 13

Claim 1 recites, in response to "detecting that a telephone set has been connected to a telephone line," **"identifying the telephone line,"** "retrieving a speed dial list... **wherein the speed dial list is associated in the database with the telephone line,**" and "communicating the speed dial list associated with the telephone line to the telephone set." The act of detecting that a telephone set has been connected to the telephone line starts the processing. Claim 8 is a system claim including similar limitations. Claim 13 defines a computer-readable medium including similar limitations. At least the **bolded** claim features of claim 1 are missing from the cited references.

In the Response to Arguments section, the Final Office Action asserts that "obviously, the line must be identified for the menu to be sent to the connect device in Koponen." However, this is clearly an application of impermissible hindsight. Koponen makes no mention of this feature, and certainly does not show, describe or suggest retrieving a speed dial list which is associated with the identified telephone line. Instead, Koponen states

The telephone exchange 2 receives the request and checks the data stored in the telephone exchange 2 about the subscriber to determine which services have been activated for the subscriber....

(column 2, lines 43-45, *emphasis added*). Thus, Koponen discloses teaching using information about the subscriber rather than the telephone line. A subscriber may have an account and the telephone exchange may store other identifying information. Since Koponen states that information about the subscriber is used to determine which services have been activated for the subscriber, Koponen is clearly teaching away from the invention of claim 1 and clearly does not suggest the features of claim 1. Further, as previously noted, Koponen instead teaches that a digital terminal device must send an update request. Column 2, lines, 40-43. In Koponen's system, such a communication provides another means of identification of the subscriber—the identification information can be delivered with the update request sent “upon start-up of the digital terminal device and/or upon connection of the digital terminal device to the telecommunication network” (column 2, lines 12-17).

Accordingly, it is respectfully submitted that Koponen fails to disclose all limitations of claim 1. The final rejection reads too much into the disclosure of Koponen—limitations of the present invention are not disclosed there. The other prior art of record fails to provide the missing teaching. Claim 1 is therefore allowable. Independent claims 8 and 13 are allowable for the same reasons.

Koponen and Lee fail to show all the features of Claim 7

Independent claim 7 is directed to a method including “receiving a telephone call automatically placed by a telephone set via a telephone line in response to the telephone set being connected to the telephone line, **providing within the telephone call an option to download a speed dial list, receiving, within the telephone call, a selection of the option to download the speed dial list,**” and “communicating the speed dial list to the telephone set.” The cited references fail to disclose all the features of claim 7, including at least the **bolded** limitations.

With respect to the option to download a speed dial list, the Final Office Action asserts that “the menu in Koponen gives one the option to download calling features or services if one

desires,” referring to “other services” in Figs. 1a and 1b. However, claim 7 actually reads, in part,

receiving a telephone call automatically placed by a telephone set via a telephone line in response to the telephone set being connected to the telephone line;
providing within the telephone call an option to download a speed dial list;
receiving, within the telephone call, a selection of the option to download the speed dial list;

(emphasis added). Thus, in accordance with the invention of claim 7, a telephone call is placed by the telephone set and, during the telephone call, the option to download the speed dial list is provided. A selection of the option is subsequently received, again, during the telephone call.

In contrast, Koponen discloses that

the transfer of service profile is performed upon start-up of the digital terminal device and/or *upon connection of the digital terminal device to the telecommunication network, in which case the digital terminal device sends a transfer request to the telephone exchange.* *(emphasis added)*

Column 2, lines 12-17, *emphasis added*. Subsequently, all services are transmitted to the subscriber in response to the subscriber's service profile request, including active services and available services. Column 2, lines 47-54. Koponen does not show, describe or suggest providing or receiving this information within a telephone call which has been automatically placed by the telephone set. The only way that Koponen can be described as disclosing this information is by using impermissible hindsight, using the claims of the present application to select and characterize portions of the disclosure of Koponen. Withdrawal of this rejection is therefore respectfully requested.

Accordingly, it is respectfully submitted that independent claims 1, 7, 8 and 13 each recite limitations nowhere shown, described or suggested in the cited references. Accordingly, withdrawal of the rejection of these claims is respectfully requested. The respective dependent claims are submitted to be allowable for the same reasons as the independent claims from which they depend. Withdrawal of the rejection of these claims is respectfully requested as well.

Claim amendments

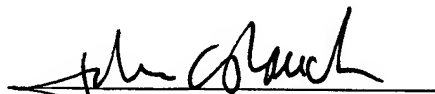
Claim 1 has been amended to correct an informality noticed during review of the claims. New claim 19 has been added to claim additional disclosed but unclaimed subject matter. No new matter is added by either of these amendments. New claim 19 finds support in the originally filed disclosure at FIG. 1, block 86 and the text associated therewith.

PAIR Issue

Upon review of the Patent Application Information Retrieval (PAIR) record for this application, it is noted that erroneous information has been entered. Specifically, the Image File Wrapper (IFW) lists "Appeal Brief Filed" with a date of February 20, 2007. A copy of the IFW listing is attached. However, upon viewing the scanned-in Appeal Brief, it was discovered that the document does not relate to the present application. Rather, the Appeal Brief is actually for another application entitled "Combination Interproximal Dental Stripper." The appeal brief specifies the US application serial number 10/664,049 for the present case, but this appeal brief obviously does not belong with the present invention. It is requested that the IFW for this application be corrected by removing the incorrectly scanned appeal brief.

With this response, the application is believed to be in condition for allowance. Should the examiner deem a telephone conference to be of assistance in advancing the application to allowance, the examiner is invited to call the undersigned attorney at the telephone number below.

Respectfully submitted,



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Search results as of: 03-23-2007::11:46:16 E.T.

This application is officially maintained in electronic form. To view: Click the desired Document Description. To Download and Print: Check the desired document(s) and click StartDownload.

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10/1/07

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application No. : 10/664,049
Applicant : STOCKSTILL, JOHN W.
Filed : SEPTEMBER 17, 2003
Title : COMBINATION INTERPROXIMAL DENTAL STRIPPER

Art Unit : 3732
Examiner : WILSON, JOHN J.

Atty Docket No. : MCOG0002-UT1

Mail Stop Appeal Brief- Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

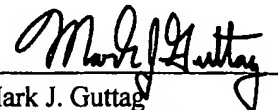
Sir:

The below-identified communication(s) is (are) submitted in the above-captioned application or proceeding:

- ☒ Appellant's Appeal Brief
- ☒ Patent Fee Transmittal
- ☒ Credit Card Payment Form (PTO-2038)

- ☒ The Commissioner is hereby authorized to charge payment of any fees associated with this communication, including fees under 37 C.F.R. §§ 1.16 and 1.17 or credit any overpayment to **Deposit Account Number 10-0233-MCOGO-0002-UT1**.

Respectfully submitted,



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